

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-7, 12, 14, 17, and 18 are pending in this application. Claims 2, 8-11, 13, 15, and 16 were previously canceled without prejudice or disclaimer. Claims 1, 3-7, 12, 14, and 18 have been amended to better describe the invention without the introduction of any new matter. Support for these claim changes is evident from the previously filed versions of these claims and Fig. 9 as well as the description in the specification starting at page 19, line 2, for example, as to acquisition and downloading of contents that have been updated.

The outstanding Official Action presents a rejection of Claims 1, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen (apparently with regard to U. S. Patent No. 6,055,570 that is incorrectly listed as “6055070” in the outstanding Action) in view of Criss et al. (apparently with regard to U. S. Patent No. 6,735,434, hereinafter Criss)¹, and a rejection of Claims 3-7, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen (again incorrectly listed as 60555070) in view of Nodoushani et al. (U. S. Patent No. 6,144,849, Nodoushani).

Turning to the rejection of Claims 1, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of Criss, it is noted that while Nielsen teaches that a user can monitor changes to information located on a network by registering with an update monitor service. However, Nielsen does not teach transmitting an update notification signal to any of the disclosed user computers to inform these user computers that the information being monitored has been updated. Instead, each user must login to the service, and “[u]pon

¹ The only “Criss et al.” document listed on the PTO accompanying the outstanding Action is U. S. Patent No. 6,735,434. The U. S. Patent Application Publication No. 20020123335, which is apparently incorrectly listed at page 2 of the outstanding Action, is the document number for Luna et al., which is noted at page 9 of the outstanding Action to be made of record and to not be relied upon. Accordingly, Luna et al. is not further treated in this response.

successful login, a list of those subscribed sites that have changed since his last visit to the monitor page is displayed to the user.” See col. 5, lines 6-8.

While col. 2, lines 46-61, of Nielsen have been indicated to teach an update notification signal (see page 2 of the outstanding Action), col. 2, lines 46-53 simply note that the monitor server will “provide information to one or more user computers about changes in content of information stored on one or more content servers,” and lines 54-61 suggest a parallel step of “providing information to one or more users about changes in content of information stored on one or more network servers.” What does not appear here, or elsewhere in Nielsen, is a teaching of the monitor server actually transmitting an update notification signal to the user computers as the mechanism for “providing” this information. Instead, and as noted above, the user computers must successfully login to the monitor service in order be provided update information as to information being monitored by the service.

Therefore, the above-noted teachings of col. 5, lines 6-8, as well as those of col. 7, lines 4-30 and col. 9, lines 10-30, make it clear that the mechanism for “providing” this information does not involve the Claim 1 required “transmitting an update notification signal indicating that said contents have been updated” to the user computers to notify them as to these updates. In the system actually taught by Nielsen, an update manager (a person or an automated process) is provided as to each monitored site and does the actual monitoring for changes. This update manager also transmits the only thing that can be reasonably called an “update notification signal,” but this update notification is transmitted to the update monitor service acting as a centralized collecting point and not to the “user” as Claim 1 requires. See col. 6, lines 6-10. The user computers can only obtain this information from the monitor service upon the above-noted successful login to the monitor service.

It is, thus, clear that the teachings of Nielsen as to providing information to the user computers about changes in content of information stored on a content server have been improperly taken out of context and improperly expanded beyond anything reasonably suggested by Nielsen. In this last respect, In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) explains that:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [reference statements] would have suggested to those of ordinary skill in the art, the [reference] statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. (Emphasis added.)

In addition, the required analysis of the base Claim 1 recited “means” and associated functions has not been performed. In this regard, the PTO reviewing court recently emphasized that conclusory findings that omit analysis as to “means” claim limitations are improper in Gechter v. Davidson 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) as follows:

In addition, the [PTO] never construed the scope of the structures disclosed in the specification for the claimed "receiving means," nor did the [PTO] expressly find that the "receiving means" disclosed in the specification was structurally equivalent to that embodied in [the reference]. Moreover, the [PTO] also failed to define the exact function of the receiving means, as well as to find that [the reference] disclosed the identical function. [Emphasis added, citation omitted.]

Besides failing to reasonably teach the Claim 1 “notifying means” and any of its functions, it is clear that Nielsen also fails to teach, among many things, the Claim 1 “storing means” and any of its functions.

To whatever extent that Criss can be said to teach mobile terminals as part of a radio telephone communication network, Criss cannot be said to cure the above-noted inadequacies in Nielsen. In this regard, it is clear that the system of Criss does not teach or suggest, among other elements, the base Claim 1 “notifying means” and its functions or the base Claim 1 “storing means” and its functions as the operation taught by Criss does not require these elements for the same reason that the system of Nielsen does not. The system of Criss is like

the system of Nielsen in “providing” information from a central source to peripheral terminals that have themselves established contact with that source. In order to secure software updates from a Criss base station, the Criss mobile terminals must contact that base station, because the base station does not send them notification that it contains an update that they requested just as the monitor service of Nielsen does not notify the users there of updates that have been made. 1

Therefore, there is no teaching or suggestion in Criss of the base Claim 1 required “notifying means” and its functions or the base Claim 1 “storing means” and its functions just as there was none in Nielsen. Accordingly, as not all of the subject matter of base independent Claim 1 can be said to be taught by Nielsen and Criss taken together, no *prima facie* case of obviousness² can be reasonably asserted to be present and this rejection should be withdrawn as being clearly improper for this reason alone.

Also, the required explanation as to what would have led the artisan to select the Criss wireless communication system to modify the internet web page based monitoring system of Nielsen is clearly lacking. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and the requirement there for the PTO to “explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious.” Establishing proper motivation to combine references further requires more than unsupported generalizations like the assertion of an “improved hybrid communication system” as at the middle of page 3 of the outstanding Action. The need for specificity pervades the case law. *See, e.g., In re Kotzab*, 217 F. 3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”) and *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340,

² It is well established that a *prima facie* case of obviousness requires that all claim limitations be considered and demonstrated to be taught or suggested by the prior art, see MPEP §2143.03.

1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) requiring the showing as to motivation to be clear and particular.

Accordingly, as the prerequisites to establishing a valid *prima facie* case of obviousness have not been followed, no valid rejection has been made as to independent Claim 1. Consequently, withdrawal of the rejection of independent Claim 1 as being unpatentable over Nielsen in view of Criss is respectfully requested.

In addition, as Claims 17 and 18 depend on Claim 1 directly or indirectly, these claims are believed to clearly patentably define over Nielsen and/or Criss taken alone or together in any proper combination for at least the reasons noted above as to parent independent Claim 1. Moreover, as Claims 17 and 18 add further features not taught or suggested by either Nielsen and/or Criss taken alone or together in any proper combination, Claims 17 and 18 are further respectfully submitted to be patentable over these applied references for this reason as well.

Just as the required analysis of the base Claim 1 recited “means” and their associated functions was not properly performed as to base Claim 1 subject matter, it has not been properly performed as to that of base Claim 3 subject matter. In this respect, Claim 3 is like Claim 1 in reciting a “notifying means for notifying a user with an update notification signal” that has not been properly analyzed and shown to be taught by either Nielsen or Nodoushani, the references relied on to reject base independent Claim 3.

Besides neither Nielsen nor Nodoushani teaching or suggesting the Claim 3 “notifying means,” it is also clear that these references do not teach or suggest the Claim 3 “radio transmitting means for transmitting the acquisition instructing signal to a prescribed information processing apparatus, said prescribed information processing apparatus responding to the received acquisition instructing signal to instruct acquisition of said contents that have been updated.”

In this regard, while the outstanding Action suggested that col. 4, lines 60-67 and/or col. 5, lines 1-5 and 21-30 of Nielsen somehow taught or suggested the Claim 3 “radio transmitting means,” there was no factual support for the assertion at the noted portions of Nielsen.

However, col. 4, lines 60-67 and col. 5, lines 1-5 of Nielsen relate to how the user would log in to the monitor service web page to obtain initial notification of whether or not any changes have occurred as to sites being monitored for changes. Independent Claim 3, on the other hand, requires that the user has already been notified of such changes and that then the user generates the claimed “acquisition instructing signal” that will cause the claimed “prescribed information processing means” to provide for “instructing acquisition of said contents that have been modified.”

Similarly, col. 5, lines 21-30 of Nielsen are not teachings of what happens after the user has received notification of a change to contents being monitored. Instead, these teachings deal with how the user first subscribes to web sites he desires be monitored using the monitor page that he has properly logged into and an “add button.” While the possibility of a change to a monitored page is noted as possibly occurring between user visits at col. 5, lines 25-30 just suggest that the user will “see the name of the site listed after the initial login.”

Moreover, to whatever extent that Nodoushani can be said to teach mobile terminals as part of a radio telephone communication network, Nodoushani cannot be said to cure the above-noted inadequacies in Nielsen.

Also, just as the required specific explanation as to what would have led the artisan to select the Criss wireless communication system to modify the internet web page based monitoring system of Nielsen is clearly lacking, so is the presentation of specific reasons why the artisan would have been reasonably led to select the Nodoushani wireless communication

system to modify the internet web page based monitoring system of Nielsen, much less any full explanation of the actual modification being proposed.

Accordingly, as the prerequisites to establishing a valid *prima facie* case of obviousness have not been followed, no valid rejection has been made as to independent Claim 3. Consequently, withdrawal of the rejection of independent Claim 3 as being unpatentable over Nielsen in view of Nodoushani is respectfully requested.

In addition, as Claims 4-7 all depend directly on Claim 3, these claims are believed to clearly patentably define over Nielsen and/or Nodoushani taken alone or together in any proper combination for at least the reasons noted above as to parent independent Claim 3. Moreover, as Claims 3-7 add further features not taught or suggested by either Nielsen and/or Nodoushani taken alone or together in any proper combination, Claims 3-7 are further respectfully submitted to be patentable over these applied references for this reason as well.

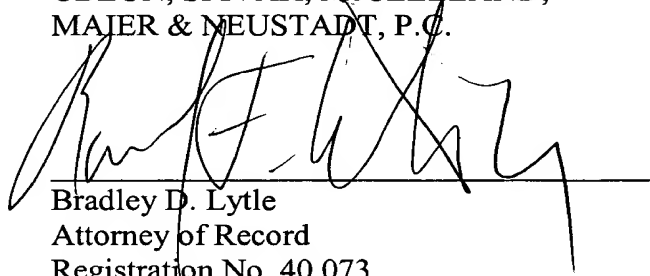
Moreover as independent Claim 12 is an apparatus claim that parallels independent Claim 3 using apparatus limitations instead of the “means” of independent Claim 3, and as independent Claim 14 is a method claim that parallels independent Claim 3 using method limitations instead of the “means” of independent Claim 3, Claims 12 and 14 are believed to patentably define over either Nielsen and/or Nodoushani taken alone or together in any proper combination for all the reasons noted above as to independent Claim 3.

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As no further issues are believed to remain outstanding relative to this application, it is respectfully submitted that this application is clearly in condition for formal allowance, and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Bradley D. Lytle', is written over a horizontal line.

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